REMARKS

Claims 1-10 are pending in the present application. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 102, Anticipation

The examiner has rejected claims 1 and 6 under 35 U.S.C. § 102(b) as being unpatentable over *Ballard*, A Method for Rendering Glyphs Using a Layout Services Library, PCT Publication WO 99/00760 (Jan. 7, 1999). This rejection is respectfully traversed.

Regarding claim 1, the Office Action asserts that:

> Regarding independent claim 1, *Ballard* discloses a method of standardizing character information in electronic documents (see page 4, line 25-page 5, line 15; the user chooses standardized glyph information) comprising the steps of: comparing character information including character code and font information for each character used in an electronic document to character information within a target replacement font set in order to automatically generate a comparison table for use during actual character information replacement (see page 4, line 5-page 5, line 15; a font is analyzed to produce a list of glyph forms, and a list is a degenerate type of table); presenting said comparison table to a user (scc page 4, lines 30-37, the user chooses glyph forms); said user amending errors in said comparison table (scc page 4, lines 30-37, the user chooses glyph forms); and actually replacing said character information including character code and font information used in said electronic document based on said comparison table as amended (the glyph is rendered at page 5, lines 10-12).

Office Action dated December 3, 2004, pp. 3-4.

Ballard does not anticipate claim 1 because *Ballard* does not show or suggest the claim limitations emphasized below:

> 1.   A method of standardizing character information in electronic documents comprising the steps of:
>   *comparing character information including character code and font information for each character used in an electronic document to character information within a target replacement font set in order to*

> *automatically generate a comparison table for use*
> *during actual character information replacement;*
> presenting said comparison table to a user;
> *said user amending errors in said comparison table; and*
> *actually replacing said character information including*
> *character code and font information used in said*
> *electronic document based on said comparison*
> *table as amended.*

The examiner asserts that *Ballard* does show the emphasized claim limitations citing, at various points, page 4, line 5 through page 5, line 15. The cited text, starting with line 2 of page 4, is as follows:

> The present invention meets the needs described above by providing a method for identifying alternative glyph forms for the user of the client program so that the user can select the appropriate glyph form for his or her needs. The present invention also provides a method for positioning the glyphs in a run of text with respect to a base line.
>
> In order to provide the advanced capabilities of selecting alternative glyph forms and complex glyph positioning, the method of the present invention employs a layout services library (server process or server) which provides a set of text processing functions for use by a word processing program or other client program. The layout services library includes font information functions, text layout functions, and text information functions. The font information functions provide information about the font. The text layout functions provide fundamental layout services including glyph substitution, glyph positioning, and justification. The layout service library is functionally situated between the client program and the operating system and communicates with the font tables. The layout services library serves the client program by accessing font information and guiding the operating system in rendering text (glyphs). The lout services library simplifies the job of text processing by insulating the client from the details of the font file format and from the details of the operating system operation. Particularly, the layout services library allows clients to work at the level of characters and features (for example, a superscript feature), with which clients are already familiar.
>
> To select an alternative glyph form, the client program defines a text run and instructs the layout services library (server) to scan the text turn and identify characters that have alternative glyph forms. In response, the layout services library returns a list of feature parameter structures, each of which contains a count of the number of glyph alternates that apply for each identified character. The

client program uses this information to assemble a list of identical
characters, each with a different parameter. The client program
then calls the layout services library to get a list of all glyph
alternatives (variants). The client program takes the list of glyph
alternatives and presents the list to the user of the client program.
After the user chooses an alternative glyph, the client program
marks the character in the text run with a feature description and
tags it with a parameter identifying which glyph alternative the
user has chosen.

To position a glyph, the client program calls the layout services
library (server) for glyph position information for each character in
a run of text. The layout services library returns information for
positioning the glyphs along a base line for the run of text.
Particularly, the layout services library returns a value for advance
of a virtual pen point along the base line, an X-placement value of
the glyph from the virtual pen point, and a Y-placement value of
the glyph from the virtual pen point. From the advance, X, and Y
information, the operating system can render the glyph in the
correct position in the rendered run of text.

The client also keeps track of the number of glyphs which are
positioned using positioning information form the layout services
library...

Ballard, p. 4, l. 2 through p. 5, l. 15. The cited text in Ballard, however, does not show

the first limitation of claim 1, "comparing character information including character code

and font information used in an electronic document to character information within a

target replacement font set in order to automatically generate a comparison table for use

during actual character information replacement."

Instead, Ballard discusses identifying glyphs (a symbol or character) in a text run

and providing a list of identical characters to the glyphs, each with a different parameter.

The list is presented to the user, who may select an alternative glyph. Ballard does not

discuss comparing character code or font information for each character or glyph.

Ballard instead relies on a layout services library to return a list of parameter structures,

each of which contains a count of the number of glyph alternates that apply for each

identified character. Thus, Ballard does not show the first limitation of claim 1.

Accordingly, Ballard does not anticipate claim 1.

Furthermore, even if Ballard could be construed as showing the first limitation of

claim 1, Ballard does not show the third limitation of claim 1, "said user amending errors

in said comparison table." Nowhere in the cited text does the user amend errors in the comparison table. The examiner asserts otherwise, citing a portion of the following text from *Ballard*:

> In response, the layout services library returns a list of feature parameter structures, each of which contains a count of the number of glyph alternates that apply for each identified character. The client program uses this information to assemble a list of identical characters, each with a different parameter. The client program then calls the layout services library to get a list of all glyph alternatives (variants). The client program takes the list of glyph alternatives and presents the list to the user of the client program. After the user chooses an alternative glyph, the client program marks the character in the text run with a feature description and tags it with a parameter identifying which glyph alternative the user has chosen.

Ballard, p. 4, l. 26 through p. 5, l. 2.

Nowhere does the cited text in *Ballard* show the *user* amending errors in a comparison table. Even if the list is considered a table, the user does not amend errors in the table. Instead, the client program marks the character in the text run and tags it with a parameter identifying which glyph alternative the user has chosen. The user has nothing to do with this automatic process. Thus, *Ballard* does not show the third limitation of claim 1. Accordingly, *Ballard* does not anticipate claim 1.

Similarly, *Ballard* does not show the fourth limitation of claim 1. The fourth limitation provides for "actually replacing said character information including character code and font information used in said electronic document based on said comparison table as amended." *Ballard* does not replace characters or glyphs based on an amended comparison table. Thus, *Ballard* does not anticipate claim 1.

Regarding claim 6, the Office Action asserts that:

> Regarding dependent claim 6, *Ballard* discloses that the comparison table is a list taking as elements a corresponding relationship between a group of a source font set and character code within this source font set and a group of a target font set and character code within this target font set (see page 4, line 5-page 5, line 15; a font is analyzed to produce a list of glyph forms, and a list is a degenerate type of table.)

Office Action of December 3, 2004, p. 4.

Ballard does not anticipate claim 6 because *Ballard* does not anticipate claim 1, from which claim 6 depends. Thus, claim 6 should be in condition for allowance.

In addition, *Ballard* does not show or suggest "a group of source font set and character code within this source font set and a group of target font set and character code within this target font set," as claimed. Instead, as shown in relation to claim 1, *Ballard* returns a list of parameter structures, not character codes and font sets. Thus, *Ballard* again does not anticipate claim 6. Therefore, the rejection of claims 1 and 6 under 35 U.S.C. § 102(b) has been overcome.

Furthermore, *Ballard* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Ballard* actually teaches away from the presently claimed invention because it teaches automatically replacing glyphs and comparing parameter structures as opposed to manually editing a comparison table and then comparing character codes and font as in the presently claimed invention. Absent the examiner pointing out some teaching or incentive to implement *Ballard* and these teachings, one of ordinary skill in the art would not be led to modify *Ballard* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Ballard* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

II.   35 U.S.C. § 103, Obviousness

II.A   Rejection of Claim 2

The examiner has rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over *Ballard*, in view of *Hube* et al., User Definable Font Substitutions with Equivalency Indicators, U.S. Patent 5,167,013 (Nov. 24, 1992) in view of *Patel* et al., Font Feature File Processing, U.S. Patent 6,426,751 (Jul. 30, 2002). This rejection is respectfully traversed.

As shown above, *Ballard* does not show the limitations of claim 1, from which claim 2 depends. As shown in previous responses, which are hereby incorporated by reference, *Hube* does not show the limitations of claim 1. As shown in previous responses, *Patel* does not show or suggest the limitations of claim 1. Thus, the proposed

combination does not result in claim 1. Because the proposed combination does not result in claim 1, the proposed combination does not result in the invention of claim 2. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection of claim 2.

In addition, the examiner has failed to a state *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to combine the references. The examiner states, in relevant part, that:

> It would have been obvious...to have this involve inputting a font set used in said electronic source document because this would give the user control over the fonts used.... It would have been obvious... to include the step of outputting a font comparison table candidate list in order to clarify how it operates to the user... It would have been obvious... to incorporate *Patel*'s teachings about rules for kanji radicals into *Hube*'s invention in order to define changes to a font.

Office Action of December 3, 2004, pp. 5-6.

Each of these statements only states a purported advantage to combining the references. The examiner has not provided a logical connection between each advantage and a reason why that advantage would motivate one of ordinary skill to combine the references to *result in the claimed inventions*. For example, even if an advantage exists as stated by the examiner, one of ordinary skill would have to recognize the advantage and have a reason to implement it. The examiner has not made this logical connection. Thus, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection.

In addition, claim 2 is non-obvious in view of the cited references because one of ordinary skill would not be motivated to combine the references when viewed as a whole. *Ballard* is directed to automatically replacing glyphs from lists of identical characters having different parameters. *Hube* is directed to a printer system which allows printing in multiple fonts, where the font to be used is specified in an encoded document to be printed. *Patel* is directed to processing a font-end editable text file that specifies features for a font, wherein the text file can be processed in combination with an existing font file to establish an enhanced font file. The three references address different problems. Moreover, each reference represents a complete solution to the problem presented by each reference. Thus, one of ordinary skill would not be motivated to combine the

references when the references are considered as a whole. Accordingly, claim 2 is non-obvious.

The examiner has failed to state a *prima facie* obviousness rejection of claim 2 and claim 2 is non-obvious in view of the cited references. Therefore, the rejection of claim 2 under 35 U.S.C. § 103(a) has been overcome.

II.B   Rejection of Claim 3

The examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over *Ballard*, in view of *Hube*, in view of *Patel*, in view of Item-Mapping Subsystem, IBM Technical Disclosure Bulletin, pp. 553-556 (June 1, 1993) (IBMTDB). This rejection is respectfully traversed.

As shown above, *Ballard* does not show the limitations of claim 1, from which claim 3 depends. As shown in previous responses, *Hube* does not show the limitations of claim 1. As shown in previous responses, *Patel* does not show or suggest the limitations of claim 1. Furthermore, the IBMTDB does not show or suggest the limitations of claim1. Instead, the IBMTDB is directed to a method of mapping one item of a given type to one or more items of another type, wherein a bi-directional, non-user editable mapping table allows for automatic one to many mappings. The IBMTDB at least does not show or suggest a user amending a comparison table as claimed. Thus, the proposed combination does not result in claim 1. Because the proposed combination does not result in claim 1, the proposed combination does not result in the invention of claim 3. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection of claim 3.

In addition, the examiner has failed to a state *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to combine the references. The examiner states, in relevant part, that:

> It would have been obvious...to incorporate the teaching of weighting of IBMTDB into *Ballard*, *Hube*, and *Patel* in order to avoid collisions in hashing schemes used in mappings.

Office Action of December 3, 2004, p. 6.

The examiner's statement only states a purported advantage to combining the references. The examiner has not provided a logical connection between the advantage

and a reason why the advantage would motivate one of ordinary skill to combine the references to *result in the claimed inventions*. For example, even if the advantage exists as stated by the examiner, one of ordinary skill would have to recognize the advantage and have a reason to implement it. The examiner has not made this logical connection. Thus, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection.

In addition, claim 3 is non-obvious in view of the cited references because one of ordinary skill would not be motivated to combine the references when viewed as a whole. *Ballard* is directed to automatically replacing glyphs from lists of identical characters having different parameters. *Hube* is directed to a printer system which allows printing in multiple fonts, where the font to be used is specified in an encoded document to be printed. *Patel* is directed to processing a font-end editable text file that specifies features for a font, wherein the text file can be processed in combination with an existing font file to establish an enhanced font file. The IBMTDB is directed to many-to-one mapping schemes for mapping one type of item to another type of item. The four references address different problems. Moreover, each reference represents a complete solution to the problem presented by each reference. Thus, one of ordinary skill would not be motivated to combine the references when the references are considered as a whole. Accordingly, claim 3 is non-obvious.

In addition, the examiner must combine four references to state the rejection. One of ordinary skill is unlikely to combine many references to achieve any particular implementation of an invention. Similarly, one of ordinary skill is unlikely to be motivated to combine many references. Thus, even though the examiner could conceivably combine more than three references to state an obviousness rejection, the fact that the examiner must state more than three references to state a rejection is strong evidence that claim 3 is non-obvious.

In addition, in the light that the proposed combination does not result in the claimed inventions and in the light that no motivation exists to combine the references, the fact that the examiner has combined more than three references indicates that the examiner merely picked and chose elements in various references and then used Applicants' own disclosure as a motivation to fashion the rejection of claim 3. Doing so

is impermissible hindsight and results in negation of the rejection. Thus, the examiner has again failed to state a *prima facie* obviousness rejection.

The examiner has failed to state a *prima facie* obviousness rejection of claim 3 and claim 3 is non-obvious in view of the cited references. Therefore, the rejection of claim 3 under 35 U.S.C. § 103(a) has been overcome.

II.C   Rejection of Claim 4

The examiner has rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Ballard*, in view of *Hube*, in view of *Patel*, in view of *Ng* et al., Rule-Based Approach to Object-Relational Mapping Strategies, U.S. Patent 6,360,223 (Mar. 19, 2002). This rejection is respectfully traversed.

As shown above, *Ballard* does not show the limitations of claim 1, from which claim 4 depends. As shown in previous responses, *Hube* does not show the limitations of claim 1. As shown in previous responses, *Patel* does not show or suggest the limitations of claim 1. Furthermore, *Ng* does not show or suggest the limitations of claim 1. *Ng* is directed to mapping rules for use in mapping data between a relational model and an object model. *Ng* at least does not show a user amending errors in a comparison table as claimed. Thus, the proposed combination does not result in claim 1. Because the proposed combination does not result in claim 1, the proposed combination does not result in the invention of claim 4. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection of claim 4.

In addition, the examiner has failed to a state *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to combine the references. The examiner states, in relevant part, that:

> It would have been obvious...to follow *Ng*'s teaching about many-to-many relationships in the context of *Ballard, Hube,* and *Patel* to have said font comparison table list take as elements groups comprising one character within a source font and a plurality of characters within a target font compatible with said source font accurately model the situation (which involves many-to-many mappings).

Office Action of December 3, 2004, p. 7.

The examiner's statement only states a purported advantage to combining the references. The examiner has not provided a logical connection between the advantage and a reason why the advantage would motivate one of ordinary skill to combine the references to *result in the claimed inventions*. For example, even if the advantage exists as stated by the examiner, one of ordinary skill would have to recognize the advantage and have a reason to implement it. The examiner has not made this logical connection. Thus, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection.

In addition, claim 4 is non-obvious in view of the cited references because one of ordinary skill would not be motivated to combine the references when viewed as a whole. *Ballard* is directed to automatically replacing glyphs from lists of identical characters having different parameters. *Hube* is directed to a printer system which allows printing in multiple fonts, where the font to be used is specified in an encoded document to be printed. *Patel* is directed to processing a font-end editable text file that specifies features for a font, wherein the text file can be processed in combination with an existing font file to establish an enhanced font file. *Ng* is directed to mapping rules between a relational model and an object model. The four references address different problems. Moreover, each reference represents a complete solution to the problem presented by each reference. Thus, one of ordinary skill would not be motivated to combine the references when the references are considered as a whole. Accordingly, claim 4 is non-obvious.

In addition, the examiner must combine four references to state the rejection. One of ordinary skill is unlikely to combine many references to achieve any particular implementation of an invention. Similarly, one of ordinary skill is unlikely to be motivated to combine many references. Thus, even though the examiner could conceivably combine more than three references to state an obviousness rejection, the fact that the examiner must state more than three references to state a rejection is strong evidence that claim 4 is non-obvious.

In addition, in the light that the proposed combination does not result in the claimed inventions and in the light that no motivation exists to combine the references, the fact that the examiner has combined more than three references indicates that the examiner merely picked and chose elements in various references and then used

Applicants' own disclosure as a motivation to fashion the rejection of claim 4. Doing so is impermissible hindsight and results in negation of the rejection. Thus, the examiner has again failed to state a *prima facie* obviousness rejection.

The examiner has failed to state a *prima facie* obviousness rejection of claim 4 and claim 4 is non-obvious in view of the cited references. Therefore, the rejection of claim 4 under 35 U.S.C. § 103(a) has been overcome.

II.D   Rejection of Claim 5

The examiner has rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Ballard*, in view of *Hube*, in view of *Patel*, in view of *Ng* in view of *Melen* et al., Selection Agent for a Symbol Determination System with Multiple Character Recognition Processors, U.S. Patent 5,257,323 (Oct. 26, 1993) . This rejection is respectfully traversed.

As shown above, *Ballard* does not show the limitations of claim 1, from which claim 5 depends. As shown in previous responses, *Hube* does not show the limitations of claim 1. As shown in previous responses, *Patel* does not show or suggest the limitations of claim 1. Furthermore, as shown above, *Ng* does not show or suggest the limitations of claim 1. *Melen* is directed to a selection agent within a symbol determination system which receives input character codes each with an associated confidence factor from a plurality of OCR processors, wherein the selection agent selects the mathematically most probable character based on the relative values of joint confidence factors. *Melen* at least does not show a user amending errors in a comparison table as claimed. Thus, the proposed combination does not result in claim 1. Because the proposed combination does not result in claim 1, the proposed combination does not result in the invention of claim 5. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection of claim 5.

In addition, the examiner has failed to a state *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to combine the references. The examiner states, in relevant part, that:

> Because confidence is analogous to priority level information, it
> would have been obvious to... follow *Melen*'s teachings to add

Page 15 of 23
Nakai et al. – 09/539,025

> priority level information for said plurality of character codes
> within said target font to aid selection among them.

Office Action of December 3, 2004, pp. 7-8.

The examiner's statement only states a purported advantage to combining the references. The examiner has not provided a logical connection between the advantage and a reason why the advantage would motivate one of ordinary skill to combine the references to *result in the claimed inventions*. For example, even if the advantage exists as stated by the examiner, one of ordinary skill would have to recognize the advantage and have a reason to implement it. The examiner has not made this logical connection. Thus, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection.

In addition, claim 5 is non-obvious in view of the cited references because one of ordinary skill would not be motivated to combine the references when viewed as a whole. *Ballard* is directed to automatically replacing glyphs from lists of identical characters having different parameters. *Hube* is directed to a printer system which allows printing in multiple fonts, where the font to be used is specified in an encoded document to be printed. *Patel* is directed to processing a font-end editable text file that specifies features for a font, wherein the text file can be processed in combination with an existing font file to establish an enhanced font file. *Ng* is directed to mapping rules between a relational model and an object model. *Melen* is directed to a selection agent within a symbol determination system. The five references address different problems. Moreover, each reference represents a complete solution to the problem presented by each reference. Thus, one of ordinary skill would not be motivated to combine the references when the references are considered as a whole. Accordingly, claim 5 is non-obvious.

In addition, the examiner must combine *five* references to state the rejection. One of ordinary skill is unlikely to combine many references to achieve any particular implementation of an invention. Similarly, one of ordinary skill is unlikely to be motivated to combine many references. Thus, even though the examiner could conceivably combine more than three references to state an obviousness rejection, the fact that the examiner must state more than three references to state a rejection is strong evidence that claim 5 is non-obvious.

In addition, in the light that the proposed combination does not result in the claimed inventions and in the light that no motivation exists to combine the references, the fact that the examiner has combined more than three references indicates that the examiner merely picked and chose elements in various references and then used Applicants' own disclosure as a motivation to fashion the rejection of claim 5. Doing so is impermissible hindsight and results in negation of the rejection. Thus, the examiner has again failed to state a *prima facie* obviousness rejection.

The examiner has failed to state a *prima facie* obviousness rejection of claim 5 and claim 5 is non-obvious in view of the cited references. Therefore, the rejection of claim 5 under 35 U.S.C. § 103(a) has been overcome.

II.E **Rejection of Claim 7**

The examiner has rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over *Ballard*, in view of *Hube*, in view of *Agazzi* et al., Method of Downsampling Documents, U.S. Patent 6,389,178 (May 14, 2002). This rejection is respectfully traversed.

As shown above, *Ballard* does not show the limitations of claim 1, from which claim 7 depends. As shown in previous responses, *Hube* does not show the limitations of claim 1. Furthermore, *Agazzi* does not show or suggest the limitations of claim 1. *Agazzi* is directed to a method of downsampling characters into a document by font substitution when the characters in the document are identified with sufficient reliability or; otherwise, character substitution is accomplished by decimation. *Agazzi* at least does not show a user amending errors in a comparison table as claimed. Thus, the proposed combination does not result in claim 1. Because the proposed combination does not result in claim 1, the proposed combination does not result in the invention of claim 7. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection of claim 7.

In addition, the examiner has failed to a state *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to combine the references. The examiner states, in relevant part, that:

> It would have been obvious... to combine *Hube*'s teachings with
> the OCR teachings of *Agazzi* to facilitate downsampling of a
> document, thereby resulting in a method wherein said step of
> comparing is carried out automatically using Optical Character
> Recognition (OCR) technology.

Office Action of December 3, 2004, p. 8.

The examiner's statement only states a purported advantage to combining the references. The examiner has not provided a logical connection between the advantage and a reason why the advantage would motivate one of ordinary skill to combine the references to *result in the claimed inventions*. For example, even if the advantage exists as stated by the examiner, one of ordinary skill would have to recognize the advantage and have a reason to implement it. The examiner has not made this logical connection. Thus, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection.

In addition, claim 7 is non-obvious in view of the cited references because one of ordinary skill would not be motivated to combine the references when viewed as a whole. *Ballard* is directed to automatically replacing glyphs from lists of identical characters having different parameters. *Hube* is directed to a printer system which allows printing in multiple fonts, where the font to be used is specified in an encoded document to be printed. *Agazzi* is directed to alternative methods of downsampling characters into a document. The three references address different problems. Moreover, each reference represents a complete solution to the problem presented by each reference. Thus, one of ordinary skill would not be motivated to combine the references when the references are considered as a whole. Accordingly, claim 7 is non-obvious.

The examiner has failed to state a *prima facie* obviousness rejection of claim 7 and claim 7 is non-obvious in view of the cited references. Therefore, the rejection of claim 7 under 35 U.S.C. § 103(a) has been overcome.

II.F   Rejection of Claim 8

The examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over *Ballard* in view of Microsoft Word: User's Guide, Microsoft Corporation, 1993-1994, Version 6.0, pages 48-50. This rejection is respectfully traversed.

As shown above, *Ballard* does not show the limitations of claim 1, from which claim 8 depends. As shown in previous responses, the User's Guide does not show the limitations of claim 1. Thus, the proposed combination does not result in claim 1. Because the proposed combination does not result in claim 1, the proposed combination does not result in the invention of claim 8. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection of claim 8.

In addition, the examiner has failed to a state *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to combine the references. The examiner states, in relevant part, that:

> It would have been obvious... to combine Microsoft Corporation
> with *Ballard* because this would have provided the user with a
> convenient means of choosing replacements for characters.

Office Action of December 3, 2004, p. 9.

The examiner's statement only states a purported advantage to combining the references. The examiner has not provided a logical connection between the advantage and a reason why the advantage would motivate one of ordinary skill to combine the references to *result in the claimed inventions*. For example, even if the advantage exists as stated by the examiner, one of ordinary skill would have to recognize the advantage and have a reason to implement it. The examiner has not made this logical connection. Thus, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection.

In addition, claim 8 is non-obvious in view of the cited references because one of ordinary skill would not be motivated to combine the references when viewed as a whole. *Ballard* is directed to automatically replacing glyphs from lists of identical characters having different parameters. The User's Guide only describes manually inserting a symbol into an electronic document. The two references address different problems. Moreover, each reference represents a complete solution to the problem presented by each reference. Thus, one of ordinary skill would not be motivated to combine the references when the references are considered as a whole. Accordingly, claim 8 is non-obvious.

The examiner has failed to state a *prima facie* obviousness rejection of claim 8 and claim 8 is non-obvious in view of the cited references. Therefore, the rejection of claim 8 under 35 U.S.C. § 103(a) has been overcome.

II.G   Rejection of Claim 9

The examiner has rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Ballard* in view of *Hube*. This rejection is respectfully traversed.

As shown above, *Ballard* does not show the limitations of claim 1, from which claim 9 depends. As shown in previous responses, *Hube* does not show the limitations of claim 1. Thus, the proposed combination does not result in claim 1. Because the proposed combination does not result in claim 1, the proposed combination does not result in the invention of claim 9. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection of claim 9.

In addition, the examiner has failed to a state *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to combine the references. The examiner states, in relevant part, that:

> Given these teachings, it would have been obvious... to have a method wherein a comparison table and a rule set describing a structure of a source electronic document are input and standardization of fonts and character code used in said source electronic document are carried out in said step of replacing said character information, because *Hube*'s invention involves all of these features except for the rule set describing a structure of a source electronic document and such a rule set would be characteristic of a stylesheet, which would aid in managing the formatting of the document.

Office Action of December 3, 2004, pp. 9-10.

The examiner's statement only states a purported advantage to combining the references. The examiner has not provided a logical connection between the advantage and a reason why the advantage would motivate one of ordinary skill to combine the references to *result in the claimed inventions*. For example, even if the advantage exists as stated by the examiner, one of ordinary skill would have to recognize the advantage and have a reason to implement it. The examiner has not made this logical connection.

Thus, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection.

In addition, claim 9 is non-obvious in view of the cited references because one of ordinary skill would not be motivated to combine the references when viewed as a whole. *Ballard* is directed to automatically replacing glyphs from lists of identical characters having different parameters. *Hube* is directed to a printer system which allows printing in multiple fonts, where the font to be used is specified in an encoded document to be printed. The two references address different problems. Moreover, each reference represents a complete solution to the problem presented by each reference. Thus, one of ordinary skill would not be motivated to combine the references when the references are considered as a whole. Accordingly, claim 9 is non-obvious.

The examiner has failed to state a *prima facie* obviousness rejection of claim 9 and claim 9 is non-obvious in view of the cited references. Therefore, the rejection of claim 9 under 35 U.S.C. § 103(a) has been overcome.

II.H   Rejection of Claim 10

The examiner has rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Ballard*. This rejection is respectfully traversed.

As shown above, *Ballard* does not show the limitations of claim 1, from which claim 10 depends. Thus, the proposed modification does not result in claim 1. Because the proposed modification does not result in claim 1, the proposed modification does not result in the invention of claim 10. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection of claim 10.

In addition, the examiner has failed to a state *prima facie* obviousness rejection because the examiner has failed to state a proper motivation to modify *Ballard*. The examiner states, in relevant part, that:

> It would have been obvious... to use Unicode for the font encoding because it is a standard for 16-bit encoding that has gained widespread acceptance.

Office Action of December 3, 2004, p. 10.

The examiner's statement only states a purported advantage to modifying *Ballard*. The examiner has not provided a logical connection between the advantage and a reason

why the advantage would motivate one of ordinary skill to modify *Ballard* to *result in the claimed inventions*. For example, even if the advantage exists as stated by the examiner, one of ordinary skill would have to recognize the advantage and have a reason to implement it. The examiner has not made this logical connection. Thus, the examiner has failed to state a proper motivation to combine the references. Accordingly, the examiner has failed to a state *prima facie* obviousness rejection.

In addition, claim 10 is non-obvious in view of the cited references because one of ordinary skill would not be motivated to modify *Ballard* when viewed as a whole. *Ballard* is directed to automatically replacing glyphs from lists of identical characters having different parameters. *Ballard* represents a complete solution to the problem presented by each reference. Thus, one of ordinary skill would not be motivated to modify *Ballard* when *Ballard* is considered as a whole. Accordingly, claim 10 is non-obvious.

The examiner has failed to state a *prima facie* obviousness rejection of claim 10 and claim 10 is non-obvious in view of the cited references. Therefore, the rejection of claim 10 under 35 U.S.C. § 103(a) has been overcome.

III.   **Summary**

Ballard does not anticipate claims 1 and 6 because, at a minimum, *Ballard* does not show a user-editable table. All of the obviousness rejections depend on this incorrect reading of *Ballard*. Therefore, the examiner has also failed to state *prima facie* obviousness rejections of any of the claims.

In addition, the examiner has selected a plethora of references, eight in all, in order to state rejections of all of the claims. The large number of references used indicates that the examiner improperly picked and chose particular elements in the art and used Applicants' disclosure to state the obviousness rejections. Doing so is impermissible hindsight. Thus, the examiner has again failed to state *prima facie* obviousness rejections of any of the claims.

In addition, as shown above, the claims are non-obvious because one of ordinary skill would not be motivated to combine the references when the references are considered as a whole. Thus, the claims are non-obvious.

Page 22 of 23
Nakai et al. – 09/539,025

IV.   <u>Conclusion</u>

It is respectfully urged that the subject application is patentable over *Ballard*, *Hube*, *Patel*, the IBMTDB, the Microsoft Word User's Guide, *Ng*, *Agazzi*, and *Melen* and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: _____ 3/21/05 _____

Respectfully submitted,

_____ (signature) _____

Duke W. Yee
Reg. No. 34,285
Theodore D. Fay III
Reg. No. 48,504
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorneys for Applicants

Page 23 of 23
Nakai et al. – 09/539,025